

**REMARKS**

Claims 1-3, 5-7 and 9-20 are presently pending. These claims have been rejected under the doctrine of obviousness-type double patenting. These claims are also rejected in view of Boothby (USP 5,684,990). Claim 1 is further amended.

**Double Patenting**

As a Terminal Disclaimer accompanies this Response, the rejection based on double patenting is rendered moot.

**Sur-Reply to Rejection of Claims 1-3, 5-7 and 9-20 under 35 U.S.C. § 103**

Applicants appreciate the Examiner's extended Response to Applicants' Remarks, in section 2 of the Office Action, pages 2-5. The extended response facilitates further amendment and response. Applicants focus on the Examiner's Response to Applicants' Arguments, as the prior papers submitted by the Examiner and the Applicants have already addressed the Examiner's arguments in other sections of the Office Action, and are incorporated herein by reference.

On page 2, the Examiner correctly asserts that use of "multiple" in the claim, like the word "plurality", only requires two data sets, not more than two. Applicants chose the wrong word for the claim. Accordingly, the claims has been amended to "more than two." With this amendment, Applicants reassert their position that the references fail to show the claimed features.

On pages 2-4, the Examiner would construct a super-set data repository for more than two data sets from passages of Boothby, plus the Examiner's view of what would have been obvious, at page 4. This is a single reference obviousness rejection, in which the Examiner acknowledges that some claimed features are missing from Boothby.

Responding to the Office Action, pages 2-4, we first note that the Examiner's argument is premised on interpretation of claim 1 as relating to a repository (status file) for two data sets, not three or more data sets. Claim 1 has been amended to substitute "more than two" for "multiple", so the premise of the argument at pages 2-4 is no longer valid. The amendment by itself is enough to traverse the basis for rejection.

The Examiner extends Boothby beyond Boothby's words with the following argument, from page 4:

... Boothby does not explicitly indicate said data repository storing user information that is a super-set of all user information stored at the data sets. However, Boothby implicitly indicates the status file P which is save after synchronization and used as input to the next synchronization, is a file containing one record per pair of synchronization handhold and desktop records, each status file record is a simple unconflicted record, due to mapping of handhold records to desktop records the use of only one set presents no problem with respect to the other set (see col. 5, lines 46-53). Further, in columns 8-9, lines 67-2, Boothby strongly suggest the invention may be used to synchronize data of two or more desktop computers, two or more notebook computer, two or more handhold computers. *Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Boothby with said data repository storing user information that is a super-set of all user information stored at the data sets*. This modification would allow the teachings of Boothby to improve the accuracy and the reliability of the data processing environment with methods providing contemporaneous synchronization of two or more clients, and provide a backup function for information in a database (see col. 3, lines 65-66).

In the prior rejection, the Examiner made essentially the same argument. We apparently were not clear in our prior response to this argument, as the Examiner has misunderstood our position.

Our position is that (1) Boothby does not teach or suggest modifying the status file P to be a super-set of information from more than two data sets to which users desire synchronization; (2) Boothby provides objective evidence of non-obviousness, because he approaches synchronization among more than two data sets in a different way, pair-wise instead of using a super-set data repository; and (3) modifying Boothby in the manner that the Examiner proposes would impermissibly change the principle of operation described by Boothby. At pages 4-5, the Examiner misidentifies Applicants' position as a simple "hindsight" argument.

Boothby does not teach or suggest modifying the status file P to be a super-set of information from more than two data sets. It is fundamental, as indicated in MPEP section 2143.01, that the Examiner rely on some evidentiary quality suggestion to modify Boothby:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The latest update to this section of the MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The outcome of cases decided even before *In re Lee* makes it clear that real evidence is required to support an asserted teaching, suggestion or motivation to modify a single reference for obviousness. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers).

The Examiner admits in the underlined passages that there is no express support in Boothby for the suggested modification. Instead, the Examiner relies on what is implicit. Applicants have difficulty following the Examiner's reasoning on page 4, where he cites col. 5, lines 46-53 and cols. 8-9, lines 67-2. The Examiner argues that Boothby "strongly suggests the invention may be used to synchronize data of two or more desktop computers ...", but the cited passage does not include any teaching, suggestion or motivation to use a data repository that is a super-set of all user information from more than two data sets for which any user desires synchronization support. Nothing in Boothby teaches, suggests, motivates, mentions or even implies the possibility of using a super-set data repository for more than two data sets. As the Examiner does not rely on anything other than Boothby, there is no objective evidence that a person of ordinary skill in the art would consider Boothby to teach the claimed invention.

Applicants reiterate that Boothby supplies objective evidence, per the *Graham* factors, that it was not obvious in Boothby's time to address synchronization of more than two data sets in the way claimed. The Examiner fairly notes that Boothby was motivated to solve the problem of synchronizing more than two data sets. Boothby understood the need, but proposed, almost in passing (col. 9, lines 6-15), a less desirable solution than claimed in this application. In *Graham* terms, Boothby is evidence of a long-felt need and failure of others to solve the problem. This is evidence of non-obviousness.

In addition, modifying Boothby in the manner suggested would impermissibly change the principle of operation that the reference describes. MPEP section 2143.01 explains that a proposed modification cannot change the principle of operation of a reference:

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.).

The Boothby passage cited by the Examiner describes maintaining a *separate status file for each pair* of more than two data sets that would be synchronized. Col. 9, line 15. A single, super-set data repository presents a different principle of operation than Boothby’s separate status file for each pair-wise synchronization. It is not permitted to change the principle of operation described by Boothby in column 9 as a basis for rejecting the claimed invention for obviousness.

None of the three positions articulated here or on page 7 of the prior response asserted that the Examiner’s conclusion was based on improper hindsight reasoning. The word “hindsight” was first introduced by the Examiner. Accordingly, use of form paragraph 7.37.03 must have been mistaken, as it was not responsive to Applicants’ stated position. (The Examiner’s reference to an argument on page 8 must be a typographical error.) Nonetheless, Applicants point out that the only source from which the Examiner has gleaned use of a super-set data repository for synchronizing more than two data sets is the Applicants’ disclosure, as there is no mention in Boothby of the claimed data repository and the Examiner does not rely on any other art. So “hindsight”

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probably does apply here.

Accordingly, Applicants have amended the sole independent claim traversed all of the new arguments made by the Examiner. The claims are in condition for allowance.

**Information Disclosure Statement**

As the present Office Action is final, an Information Disclosure Statement accompanies this response, together with a Request for Continued Examination.

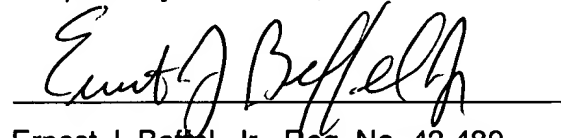
**CONCLUSION**

Applicants respectfully submit that the claims, as stated and amended herein, are in condition for allowance and solicit acceptance of the claims, in light of these remarks.

If the Examiner disagrees and sees amendments that might facilitate allowance of the claims, a call would be appreciated.

Should any questions arise, the undersigned can ordinarily be reached at his office at 650-712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone 415-902-6112 most other times.

Respectfully submitted,

A handwritten signature in cursive script, reading "Ernest J. Beffel, Jr.", written over a horizontal line.

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